

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number: 10/678,400
Filing Date: October 3, 2003
Applicant(s): Robert M. Congdon and Wei-Lee H. Jamrog
Entitled: N-TIER CONFIGURED IMAP SERVER
Examiner: Hussein A. El-Chanti
Group Art Unit: 2157
Attorney Docket No.: LOT920030027US1 (7321-012U)

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated May 27, 2010 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellants respectfully submit that in the Decision, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Appeal Brief of June 2, 2008 (the "Appeal Brief"), and in the Reply Brief of September 22, 2008 (the "Reply Brief"). Appellants will specifically identify these particular points below.

REMARKS

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. '706, to appeals of PTO rulings). Thus the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's legal conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000).

THE REJECTION OF CLAIMS 1 THROUGH 14 UNDER 35 U.S.C. § 102

On page 8 of the Decision, the Honorable Board addressed Appellants arguments of the Appeal Brief at 4 and the Reply Brief at 3, in which Appellants argued that DeAnna lacked a teaching of "application server nodes" and that Examiner had improperly and overbroadly construed "application server nodes" to mean "servers". Specifically, the Board stated,

Although we agree with Appellants' contention (Reply Br. 4) that the use of the term "application server node" in claim 1 is consistent with paragraph 11 of the Specification (see FF 1), we determine that this does not preclude the Examiner's interpretation of DeAnna's application operating on a server as also being consistent with this term. In other words, Appellants' originally filed claims and Specification, specifically at pages 5 (FF 1) and 9 (FF 2) cited by Appellants in the Reply Brief (see Reply Br. 3-4 citing paragraphs 11 and 22), do not limit or otherwise define the term "application server nodes" such that claim 1 does not encompass DeAnna's application server (e.g., ZDF server 50), IMAP compliant mail server (element 10, 173, and 175 in Fig. 4), and logical grouping of applications (171, 172, and 174).

Thus, the Board has determined the meaning of "application server nodes" to be ambiguous and thus inclusive of "application operating on a server".

Yet, the evidence of record demonstrates the industrially understood meaning of "application server" as a "server that hosts an API to expose Business Logic and Business

Processes for use by other applications". Neither the Board nor the Examiner contested this fact and provided with evidentiary support an alternative meaning. Clearly, an application executing in a server is much broader in concept and scope than that of an application server. Further, the claimed term "application server nodes" is much more than a single or multiple different applications executing on a server. The very phrase "application server nodes" explicitly requires multiple different nodes, each with an application server. Accordingly, to maintain consistency in the analogy of the Board, DeAnna would be required to show different nodes of a network, each with a server, each server hosting one or more applications and an IMAP server coupled to a logical grouping of these servers. DeAnna does not.

It is true that Appellants have not claimed "application server nodes, each of the nodes hosting execution of an application server, each application sever hosting an API to expose business logic and business processes for use by other applications".

Nevertheless, the plain claim language of "application server nodes" provides a specific meaning that distinguishes past the basic concept of an application executing in a server as argued by Appellants. Given the foregoing clarification, and for the reasons set forth in the Appeal Brief and the Reply Brief, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 102.

Date: July 27, 2010

Respectfully submitted,

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